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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,691	03/26/2001	Gary D. Schlaeger	5989.36002	8756
21000	7590	12/15/2003	EXAMINER	
DECKER, JONES, MCMACKIN, MCCLANE, HALL & BATES, P.C. BURNETT PLAZA 2000 801 CHERRY STREET, UNIT #46 FORT WORTH, TX 76102-6836			CELSA, BENNETT M	
			ART UNIT	PAPER NUMBER
			1639	
DATE MAILED: 12/15/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/817,691

### Applicant(s)

SCHLAEGER, GARY D.

### Examiner

Bennett Celsa

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 1-11 are currently pending.

Claims 1-6 and 8-10 are withdrawn from further consideration as being drawn to a nonelected invention

Claims 7 and 11 are under consideration.

### ***Election/Restriction***

1. Applicant's election of Group III (claims 7 and 11), and the "species of hydrophobic compositions" with traverse, in the response dated 10/14/03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-6 and 8-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

### ***Specification***

3. The abstract of the disclosure is objected to because "cosmic" in line 1 should be - -- cosmetic ---. Correction is required. See MPEP § 608.01(b).

### ***Priority***

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the

specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). In the present instance, the cross-reference needs to be updated to indicate the patenting of the parent application.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (NEW MATTER REJECTION/LACK OF WRITTEN DESCRIPTION).

In claim 7, the phrase “**solid waxes** extracted from vegetative plants” appears to lack specification support.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claims 7 and 11, the term "*bifluous*" process and means is not definite since there's neither an art-recognized or dictionary meaning of this term nor does the specification provide a definition. Does this term refer to two fluids (e.g. bifluidic)? two phases (e.g. biphasic)? Or have some other meaning.

B. In claim 7, the phrases: "*certain*" "heterogenous active ingredients", "blends of biocides ..." , "aqueous extracts..." is indefinite as to the metes and bounds of ingrediens, biocides, and extracts et. al. within the scope of the presently claimed invention.

C. In claim 7, the phrase "blends of **the** carrier waxes" and "the blends" lack antecedent basis.

D. In claim 7, the phrase "various means" (each occurrence) and "various thixotropic means" is indefinite as to the means encompassed by the claimed invention.

E. In claim 7, the phrase "the blends of the preferred solid and liquid additives' lack antecedent basis regarding both "blends" and "additives" (are these the same as "active ingredients") and lacks metes and bounds regarding what constitutes or is encompassed as being "preferred ... additives".

F. In claim 7, the phrase "the wax based carrier and additives" lacks antecedent basis with respect to both "the ... carrier" and "additives".

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- G. In claim 7, the phrase "the additives evenly dispersed" lacks antecedent basis regarding "additives".
- H. In claim 7, the phrase "the aqueous hydrophilic active ingredients" lack antecedent basis.
- I. In claim 11, the phrase "said composition(s)" (each occurrence) lacks antecedent basis.
- J. The claim 11 method is incomplete for failing to assert method step(s) for accomplishing the preamble method objective of "inserting a multiplicity of alternate layers of thin solid waxes and impenetrable separating members collectively into tubular containers ..."
- K. In claim 11, the phrase "inorganic and mineral oils when emulsified with the co-polymers polyethylene glycol and dimethicone copolymer" is indefinite as to the present or absence of co-polymers.
- L. In claim 11, the phrase "the copolymers polyethylene ... copolyol" lack antecedent basis.
- M. In claim 11, the phrase "the total of which ... said composition" lacks antecedent basis regarding both "total" and what components constitute "the total".
- N. In claim 11, the term "a combination of fragrant microbial biocides" is unclear as to whether a combination of biocides or a combination of fragrances and microbial biocides are being claimed.
- O. Claims 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the

steps. See MPEP § 2172.01. The omitted steps are the use of PEG and dimethicone copolyol which are critical to forming the requisite "invert emulsion"

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>©</sup> of this title before the invention thereof by the applicant for patent.

10. Claim 7 is rejected under 35 U.S.C. 102(a,e) as being anticipated by Peters et al. US Pat. No. 5,744,146 (4/98: filed 4/96) and Leong US Pat. No. 5,296,166 (3/94) cited as evidence to demonstrate inherency.

The present claims are drawn to a method of making a "solid invert emulsified composition" for intended use as a "haicare cosmetic" by mixing/heating (e.g. thermal/mechanical) a composition comprising

a. oil(s) (essential and lipophilic)

b. "solid waxes extracted from vegative plants" where a + b is not more than 80% by weight; and

c. additives including "certain blends of biocides including germicides, fungicides, bactericides and viricides" (not more than 20%)

to form a liquid and then dispensing the liquid into a container for in situ solidification.

Peters et al. teach a method of making "cosmetic stick formulations" (e.g. see col. 1-2; 5 ) by mixing/heating (e.g. thermal/mechanical a composition comprising:

a. Essential (e.g. derived from plants) and lipophilic oils: see e.g. Peters col. 4, lines 46 disclosing both plant and animal derived oils including "botanicals" , and variouos oils (e.g. mineral , coconut, avocado, olive , vegetable etc.).

b. Wax (as the "anhydrous delivery vehicle" e.g. see col. 2-3) including paraffin/beeswax/petrolatum; where a + b is not more than 80% by weight; and

c. additives including "certain blends of biocides including germicides, fungicides, bactericides and viricides" (not more than 20%) . See e.g. '146 at col. 4 ("bacericides", "antiseptics"). See also examples, Tables I-V; and patent claims 1-5.

to form a liquid and then dispensing the liquid into a container for in situ solidification (e.g. see Peters at col. Col. 4, lines 56-68.

Thus, the Peter's reference teaches all of the material limitation of the presently claimed invention including the method steps and compositional components as presently required.

To the extent that the Peters et al. reference fails to teach a "haircare cosmetic" it is noted that intended use limitations are deemed inherent or alternatively are not given



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patentable weight since there is no method step directed to actual use as a haircare cosmetic.

The Leong '166 patent reference is cited as evidence that the Peter reference method inherently results in the creation of a "solid invert emulsified composition" . See e.g. Leong abstract; col. 3 (line 60) to col. 4 (line 10).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al., U.S. Pat. No. 5,474,778 (12/95), Peters et al. US Pat. No. 5,744,146 (4/98: filed 4/96) and Leong US Pat. No. 5,296,166 (3/94) cited as evidence to demonstrate inherency.

Ichikawa et al. disclose oil-wax based cosmetic compositions which can be formulated into hair-care products including "stick pomade" (e.g. see col. 7, lines 34-40) or alternatively into other cosmetic products e.g. lip rouge (e.g. see col. 7, lines 25-35). Ichikawa et al. disclose hair care compositions comprising waxes, oils, pigments, perfumes and preservatives, bactericides, germicides in amounts within the scope of the presently claimed compositions . See col. 8 and examples in col. 21-25.

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Additionally, Ichikawa et al. disclose anhydrous "lip stick" composition which contains waxes, oils, perfumes, antioxidants, preservative, colorants and water all in amounts within the scope of the presently claimed invention (e.g. see col. 25-26, application examples 9-11).

Ichikawa et al. differs from the presently claimed invention by failing to teach mixing/heating (e.g. thermal/mechanical) of its composition and subsequent dispensing in a container for in situ solidification into a "solid invert emulsified composition".

However, Peters et al. US Pat. No. 5,744,146 (4/98; filed 4/96) teach that making cosmetic stick compositions includes the steps of mixing/heating oils/waxes and additives with subsequent dispensing in a container for formation of solid emulsified compositions. See e.g. Peters et al. at col. 4. The Leong '166 patent reference is cited as evidence that the Peter reference method inherently results in the creation of a "solid invert emulsified composition". See e.g. Leong abstract; col. 3 (line 60) to col. 4 (line 10).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the Peter's method of making solid emulsified wax-based haircare cosmetics with the Ichikawa compositions since the Ichikawa reference provides explicit motivation to make such compositions (e.g. hair caring; stick pomades: see Ichikawa at col. 7).

13. Claim 7 is rejected under 35 U.S.C. 103 as being obvious over Peters et al. US Pat. No. 5,744,146 (4/98; filed 4/96) and Leong US Pat. No. 5,296,166 (3/94) cited as

evidence to demonstrate inherency further in view of Ichikawa et al., U.S. Pat. No. 5,474,778 (12/95).

The present claims are drawn to a method of making a "solid invert emulsified composition" for intended use as a "haircare cosmetic" by mixing/heating (e.g.

thermal/mechanical) a composition comprising

- a. oil(s) (essential and lipophilic)
- b. "solid waxes extracted from vegative plants" where a + b is not more than 80% by weight; and
- c. additives including "certain blends of biocides including germicides, fungicides, bactericides and viricides" (not more than 20%)

to form a liquid and then dispensing the liquid into a container for in situ solidification.

Peters et al. teach a method of making "cosmetic stick formulations" (e.g. see col. 1-2; 5 ) by mixing/heating (e.g. thermal/mechanical a composition comprising:

- a. Essential (e.g. derived from plants) and lipophilic oils: see e.g. Peters col. 4, lines 46 disclosing both plant and animal derived oils including "botanicals" , and variouos oils (e.g. mineral , coconut, avocado, olive , vegetable etc.).
- b. Wax (as the "anhydrous delivery vehicle" e.g. see col. 2-3) including paraffin/beeswax/petrolatum; where a + b is not more than 80% by weight; and
- c. additives including "certain blends of biocides including germicides, fungicides, bactericides and viricides" (not more than 20%) . See e.g. '146 at col. 4 ("bacericides", "antiseptics"). See also examples, Tables I-V; and patent claims 1-5.

to form a liquid and then dispensing the liquid into a container for in situ solidification (e.g. see Peters at col. Col. 4, lines 56-68.

Thus, the Peter's reference teaches all of the material limitation of the presently claimed invention including the method steps and compositional components as presently required.

The Leong '166 patent reference is cited as evidence that the Peter reference method inherently results in the creation of a "solid invert emulsified composition" . See e.g. Leong abstract; col. 3 (line 60) to col. 4 (line 10). To the extent that the Peters et al. reference fails to teach a "haircare cosmetic" it is noted that intended use limitations are deemed inherent or alternatively are not given patentable weight since there is no method step directed to actual use as a haircare cosmetic

Alternatively, the use of the Peter's oil/wax cosmetic as "haircare cosmetics" would nevertheless be obvious in view of the Ichikawa et al. Reference which provides express motivation to utilize Peter's cosmetic sticks in the haircare field (e.g. stick pomade). See e.g. '778 at col. 7.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Celsa whose telephone number is 703-305-7556. The examiner can normally be reached on 8-5.

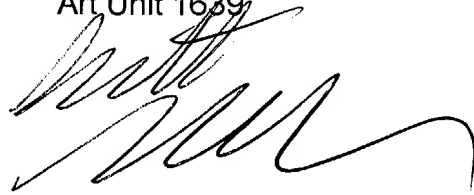
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Bennett Celsa  
Primary Examiner  
Art Unit 1639

BC

A handwritten signature in black ink, appearing to read 'Bennett Celsa', written over the printed name and title.